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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,606	02/25/2002	Mark A. McNeilage	14-02	1625

23713 7590 11/20/2002

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SUITE 201
BOULDER, CO 80303

EXAMINER

HWU, JUNE

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 11/20/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/084,606

Applicant(s)

MCNEILAGE ET AL.

Examiner

June Hwu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

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DETAILED ACTION

Drawings

The drawings are objected under 37 CFR 1.84 (e), as photographs mounted on paper are no longer accepted. See MPEP 1606. Replacement photographs are required.

The drawings should NOT be sent to the 20231 zip code address for the United States Patent and Trademark Office. Please direct all replies to the United States Patent and Trademark Office via one (1) of the following:

1. Hand carried directly to:

**1911 South Clark Place
Crystal Mall One, 7th Floor Receptionist Area
Arlington, Virginia 22202**

2. Mailed to:

**U.S. Patent and Trademark Office
P.O. Box 2327
Arlington, Virginia 22202**

Title

The title must relate to the entire "plant". The following title is suggested: "Kiwi Plant Named 'Hortgem Rua'". See MPEP 1610.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the

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case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In plant application filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164

(reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The

following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) because the specification presents less than a full and complete botanical description and the characteristics which distinguish over related known varieties.

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More specifically:

- A. The Latin name of the genus, species and variety denomination of the claimed plant should be stated and preceded by the heading set forth in 37 CFR 1.163(c)(4), (c)(5) and (d). See MPEP 1605. Correction by adding such a name is required.
- B. Applicants must provide more meaningful color description for the instant variety with reference to a recognized color chart of applicant's choice. The RHS Colour Chart is recommended. Applicants should supplement the general color descriptions currently set forth with color designations from the employed color chart, for such botanical features as stem, stipules, pedicel, peduncle, outer pericarp at maturity, inner pericarp, fruit core at harvest, seed color in flesh, and seed color when dry. See MPEP § 1605.
- C. Page 3, lines 13 and 15, the recitation "reddish-brown" is vague and does not describe the color designation with reference to an employed color chart of the bark.
- D. Applicants should set forth in the specification the average stem's diameter and surface texture in the interest of providing as complete a botanical description of the plant as is reasonably possible.
- E. Page 3, line 17, the recitation "Medium" is vague and does not quantitatively describe the average size of the lenticels. Correction is necessary.
- F. Applicants should set forth in the specification the petiole's diameter and color designation with reference to an employed color chart.

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G. Page 3, line 21, the recitation "medium stipule size" is vague and does not quantitatively describe the average size of the stipules. If available, applicants should set forth in the specification the surface texture of the stipules. Corrections are necessary.

H. Page 3, line 21, the recitation "medium time of bud burst" is vague as to a given period of time when bud's burst. Clarification and correction are necessary.

I. Page 3, line 21, the recitation "green" is vague and does not describe the color designation of the leaf blade (upper and lower sides) with reference to a color chart. In addition, Applicants should set forth in the specification the leaf blade's shape, apex shape, base shape, and anthocyanin coloration, if any. Correction and clarification are necessary.

J. Page 3, line 23, the recitation "Small" is vague and does not quantitatively describe the average size of the flower buds. Correction is necessary.

K. Page 3, lines 26-27, the recitation "green-white" is vague and does not sufficiently describe the color designation of the petals with reference to an employed color chart. In addition, Applicants should set forth in the specification the petal's size (length and width), average flower diameter, and flower arrangement. Clarification and correction are necessary.

L. Applicants should set forth in the specification the pedicel's length and surface texture in the interest of providing as complete a botanical description of the plant as is reasonably possible.

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M. Page 3, line 27, the recitation "small" is vague and does not quantitatively describe the average size of the sepals. In addition, Applicants should set forth in the specification the color designation of the sepals rather than in general color terms. Correction and clarification are necessary.

N. Applicants should set forth in the specification the average number of stamens and styles. In addition, Applicants should import in the specification the average length of the filament, anther, style and ovary. Applicants should also import in the specification the color designation with reference to an employed color chart of the filaments, anthers, style and ovary. Corrections are necessary.

O. Page 4, line 3, the recitation "Small to medium" is vague and does not sufficiently describe the average size of the fruit. Applicants should set forth in the specification the fruit's core diameter and locule number. Correction and clarification are necessary.

P. If additional information is available relative to plant/fruit disease and pest resistance/susceptibility such should be set forth in the specification or if not observed state -- none --.

Q. Applicant should import into the specification the plant hardiness zone or the heat/cold resistance of the claimed plant.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class.

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Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

Claim Rejection

35 USC § 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

Comments

Due to the amount of revision seen necessary in this application, it is suggested that Applicant file a substitute specification, incorporating all additions, deletions and modifications so as to provide the printer a clean copy at the time of allowance. Applicant should specifically authorize cancellation of the present specification to the same.

Future Correspondence

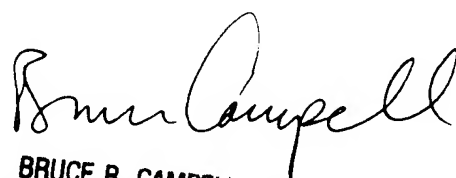
Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (703) 308-5017. The Examiner can normally be reached Monday through Friday from 6:30 a.m. to 4:00 p.m. and off alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or (703) 308-4242.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service Center whose telephone number is (703) 308-0198.

JH


BRUCE R. CAMPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600